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No. 20,599

United States Court of Appeals

For the Ninth Circuit

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| LENSLEY EQUIPMENT COMPANY, INC., | } |
| <i>Appellant,</i>                |   |
| VS.                              |   |
| ISCO CORPORATION,                | } |
| <i>Appellee.</i>                 |   |

APPELLANT'S REPLY BRIEF

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# United States Court of Appeals

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HENSLEY EQUIPMENT COMPANY, INC.,  
*Appellant,*

vs.

ESCO CORPORATION,  
*Appellee.*

### APPELLANT'S REPLY BRIEF

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Esco's brief has mischaracterized numerous statements in the record and in Hensley's brief. While many of these mischaracterizations are minor, it is felt that the more serious ones should be succinctly clarified and brought to the attention of the Court as summarily as possible.

1. With respect to its guillotine test, Esco asserts Esco Br. 6, 9, 37) that 6,000 foot-pounds of impact has been found to be a satisfactory *minimum*. At page 37 of its brief, Esco goes so far as to quote the term "minimal requirements" in describing its test. No record reference is cited in support of this quoted characterization and we think there is none. Rather, Mr. Eyolfson has stated:

"And for at least three years we have determined that for this particular size of tooth a 6,000 foot-pound level will eliminate major flaws that would cause difficulty in operation, and even though much

harder blows are withstood in operations, this seems to sort out the poor quality. And so at that level this tooth passed our *normal* proof test.” (emphasis supplied) (Rep. Tr. 63)

2. Esco asserts (Esco Br. 8, 30) that Hensley has admitted the stabilizing function of “the rearwardly extending tongues”. The actual statement of the witness cited to support this assertion is that the tongues will “probably” provide support “if they fit snugly in the recesses” (Rep. Tr. 182). It has not even been alleged that the tongues of any of the teeth in question (whether of Esco or Hensley manufacture) fit *snugly* in the recesses.

3. Esco asserts (Esco Br. 10, 31) Hensley has admitted that the “dynamic test” is the only reliable test. The actual statement at trial was that the question to be determined was whether contact results when the equipment is “in use” (Rep. Tr. 499). There was clearly no admission as to the type of test which is reliable. Moreover, Esco’s own expert, as to its guillotine test, admitted that the test was not universally accepted. Mr. Eyolfson after discussing the guillotine test, at pages 616 to 618 of the Reporter’s Transcript, concludes at page 618, “I will accept the test based upon my experience. Others may not”.

4. Esco asserts (Esco Br. 15, note 5) that Hensley contentions of the actual usage of Mekeel is at variance with representations made during hearing on Motion for Summary Judgment. Any apparent variance is due to Hensley’s attorney’s becoming aware of the actual usage of Mekeel (the Esco Model R-34D, Def. Ex. B) only *after*

that hearing. Esco also asserts (Esco Br. 22) that “it was admitted unqualifiedly that nothing ever came of Mekeel”. No record citation was noted for this “unqualified admission”. There was no such admission.

5. Esco proposes its “three-step logic” (Esco Br. 27) to attack Hensley’s contention that Esco’s own commercial construction did not come under the definition of Claims 8 and 9. But both the first and second premises of Esco’s “logic” are fallacious. Even if the early Hensley point did infringe the patent (Esco’s first premise) it does not follow that Claims 8 and 9 particularly were infringed. The infringement, if any, might well have been with respect to Claim 5 which was urged at the trial to be infringed by inducement. Moreover, there is no evidence that Hensley’s points were “copies” of the Esco commercial points as set forth in Esco’s second premise. Rather, the testimony is the exact converse (Rep. Tr. 71).

6. Esco partially quotes (Esco Br. 37) from *Chicago Pneumatic Tool Co. v. Hughes Tool Co.*, 97 F.2d 945, 947 (10th Cir. 1938) in such a manner as to infer that the Court there held adjacent *pyramidal* teeth to have their sides “approximately parallel” within the meaning of the claim language there involved. With such a holding it would appear that the sides of a pyramid would be “approximately parallel” within patent claim language. But there was no such holding. In the portion of the quote represented in Esco’s brief by an ellipsis, the Court states “[the teeth] are slightly larger at the base than at the cutting edge, but *they are not pyramidal* in shape; . . .” (emphasis supplied).

7. In answer to Esco's "haunting question" (Esco Br. 39) as to why Hensley kept the rearwardly extending tongues, Clyde Hensley himself has answered that the extension of the ears helps out in "appearance only" (Pl. Ex. 14, p. 49). Hensley's use of the rearwardly extending tongues is no proof of their patentability and in the absence of a *valid* patent Hensley had a right to use them. As recently stated by the Supreme Court in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964):

"What Sears did was to copy Stiffel's design and to sell lamps almost identical to those sold by Stiffel. This it had every right to do under the federal patent laws. That Stiffel originated the pole lamp and made it popular is immaterial. 'Sharing in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested.' *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) at 122, 83 L ed at 80."

See also, *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

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### CONCLUSION

Esco's brief does not overcome the arguments or alter the conclusions reached in Hensley's main brief.

Dated, San Francisco, California,

August 6, 1966.

Respectfully submitted,

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